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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,278	02/08/2001	Yoshinobu Meifu	FUJI 18.311	4111

7590 08/30/2005

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EXAMINER

BROOKS, MATTHEW L

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,278

Applicant(s)

MEIFU ET AL.

Examiner

Matthew L. Brooks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of the portable communication terminals and the separate input devices must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 1st

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claim 6** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examiner is uncertain how a "shot button" works or what it is in compared to and "input button" and "holed out" button as used in claim 4. Furthermore Examiner is uncertain how the unit can store measurement data if the "shot button" is pressed prior to making a shot or any generation of data has occurred.

Claim Rejections - 35 USC § 112 2nd

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 4** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant states "...an input button is pressed at a location..." due to the amendments made examiner is by whom or on which device the input button is pressed. Appropriate correction is required.

6. **Claim 9** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has added the limitation that the device is "separate" from yet "coupled to the portable communication terminal". Examiner has

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turned to the Merriam's OnLine Dictionary for the definition of both terms. Separate is 1

a : to set or keep apart or **2** : to become divided or detached or **3** : to sever an association. Couple is **1** : to connect for consideration together or **2** : to join for combined effect or **3 a** : to fasten together : LINK **b** : to bring (two electric circuits) into such close proximity as to permit mutual influence. The words as used completely contradict.

7. **Claim 9** recites the limitation "storing and managing *the* received data" in "*individual data storage unit*". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 9-11** are rejected under 35 U.S.C. 102(b) as being taught by Patent Number 5,245,537 (Barber).

10. With respect to **Claim 9**: Barber discloses

A method of managing golf data of one or more individual player, which golf data is transmitted between a portable communication terminal and a data center via a communication network, said method comprising the steps of:

storing course map data of a plurality of golf courses in a common data storage unit (Column 3, 47-50 "golf course topographical data" and Figs 2, 6, and 7);

transmitting play data or practice data to the portable communication terminal wherein said separate input device is coupled to the portable communication terminal via a signal line, infrared signal or radio frequency signal (Column 2, 24-30; "input keypad connected to microprocessor", microprocessor is housed in a portable communication device to be considered to be the equivalent of Applicant's portable communication device and Barber's "input keypad" is equivalent to Applicant's "separate input device");

receiving the play data including measurement data and a score provided with an individual identification number supplied from the portable communication terminal, or the practice data provided with the individual identification number (Column 2, 30-42 and Fig. 9 "member ID");

storing and managing the received data in an area corresponding to the individual identification number in the individual data storage unit (Column 20-40);

reading out the course map data from the common data storage unit or the play data corresponding to the individual identification number from the individual data storage unit, in response to a course map data request or a play data request provided with the individual identification number supplied from the portable communication terminal (Column 2, 17-25 and Column 2, 41-68);

and transmitting the read-out course map data or the play data to the portable communication terminal (Column 2, 41-50).

11. With respect to **Claim 10**: Barber discloses

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determining a current location on the course map according to the measurement data, in response to an advice request provided with the individual identification number and the measurement data supplied from the portable communication terminal (Column 2, 41-68);

producing advice data on choice of a golf club or a shot at the current location based on the play data and the practice data corresponding to the individual identification number stored in the individual data storage unit (Column 2, 21-31);

and transmitting the advice data to the portable communication terminal that has issued the advice request (Column 2, 39-41).

12. With respect to **Claim 11**: Barber discloses

determining the current location on the course map according to the measurement data in response to an advice request provided with the individual identification number and the measurement data supplied from the portable communication terminal (Column 2, 41-48);

analyzing the play data and the practice data corresponding to the individual identification number stored and managed by the individual data storage unit (Column 2, 41-68);

producing the advice data on the choice of golf clubs and shots based on performance data obtained from a failed shot ratio, shot distance data of each golf club, and target distance data (Column 2, 21-23);

and transmitting the advice data to the portable communication terminal that has issued the advice request (Column 2, 40-41).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 1-6 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Number 5,507,485 (Fisher) in further view of Patent Number 5,245,537 (Barber).

With respect to **Claim 1**: Fisher discloses a golf data management system comprising: a portable communication terminal and data center which are both capable of transmitting and receiving data (Column 5, 55-57; "golf computer 14" and "host computer 11") wherein the portable communication terminal comprises:

a recording unit that records play data (Column 6, 50 and Column 7, 6-7 and Column 12, 29-30);

a transmission unit that transmits the play data to data center after each hole (Column 5, 59-60) If the people in the club house can keep track of the golf game on a real time basis, play data from the golf computer must be transferred from golf computer to host computer after each hole;

a display unit (Column 6, 16-18 "display means 16") which displays the stored data (Column 6, 41-45);

Fisher does not disclose that the portable communication terminal adds an individual identification number of a player. However, Fisher does add an individual identification number at the "host computer" (Column 8, 59-62 "ID number is input 234") and is arbitrary at which point the identification number added and to add the ID number at the portable communication terminal would be obvious at the time the invention was made to a person having ordinary skill in the art.

Fisher discloses a data center (Column 5, 56; "host computer11") that is capable of transmitting or receiving data to and from the portable communication terminal (Column 6, 10-14)

Fisher discloses a data center which comprises:

an individual data storage unit that manages practice and play data corresponding to the individual (Fig. 20, Column 6, 1-6, Column 9, 42-49);

Fisher does not disclose, per se, a separate computer composing an individual data storage center, common data storage unit, and/or output unit in response to request from the portable communication terminal. However, Fisher does disclose all of the afore mentioned components within the portable communication terminal (see below) and contemplates keeping the individual data, play data and course information in a separate datacenter or database and then accessing by a communication means (Column 9, 42-52). Also, it would be obvious to a person of ordinary skill in the art to keep the information in a separate data center in order to keep the actual size of the portable communication terminal a smaller size.

Fisher discloses a common data storage unit storing course map data of a plurality of golf courses (Fig. 20 and Column 9, 15-23). Examiner notes that CD and CD ROM is a common data storage unit and is capable of storing a plurality of courses. In addition Fisher discloses that information/transferable memory regarding "course data" may be may be inserted into a "host computer" and/or accessed by a wireless means (Column 6, 6-14). Thus, Fisher fully anticipates course map data of a plurality of golf courses. Further still a duplication of parts/steps for multiple effects is well-known and obvious under 103. See *In re Harza*, 124 USPQ 378, CCPA 1960 or *St. Regis paper co. vs. Bemis co.* CCPA 1977.

Fisher is capable of outputting play data, the play data stored in the individual data storage unit in response to a request from the portable communication terminal. Fisher through out indicates that the "host computer" is used in conjunction with the "golf computer" (Column 5, 55-57). Also, Fisher shows individual information entered into the host computer at check in (Fig. 17). Although Fisher used IC cards to transfer the information, Fisher contemplated that the IC cards were not necessary and the information could be transferred by a wireless means (Column 6, 12-14). Thus, Fisher fully discloses and anticipates the output unit.

Fisher discloses the use of an input device/ portable communication terminal mounted in a golf cart and keeping track of groups and sub-groups and on an individual basis with in those sub-groups and updating all the members of the sub-group of the individual's score data (Column 1, 48-58 and Column 4, 30-42).

Fisher does not disclose wherein said portable communication terminal is carried by each player and is connectable to a separate input device via a signal line, infrared signal or radio frequency signal, and is configured to receive at least a portion of the play data from the separate input device.

HOWEVER, in further view of Patent No. 5,245,537 "Barber", which discloses each player using their own separate input device or portable communication terminal (Column 2, 25-25 and Column 5, 4-18) working in conjunction with a database. Said database contains certain past performance player information and topographical data, which may be requested from and downloaded to the portable communication device (Column 2, 30-41 and Column 5, 43-57 and Column 6, 35-40). And Barber shows the input device separately connectable to a portable device (Column 2, 27-30).

To modify Fisher by merely giving a portable device to all players would be obvious at the time of the invention in order to allow user mobility on the golf course and accurate continuous tracking of players with out the need of cart as taught by Barber (Column 1, 63-68 and Column 2, 1-5).

15. With respect to **Claim 2**: Fisher discloses using data recorded from an individual golfer's portable communication terminal to produce individual advice for the player (Column 12, 1-9 and Fig. 23).

16. With respect to **Claim 3**: Fisher discloses using data of an individual golfer's past performance to produce individual advice for the player (Column 9, 55-64 and Column 1, 65-68).

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17. With respect to **Claim 4**: Fisher discloses a portable communication terminal comprising a recording part recording part that records measurement data (Column 6, 49-52 and Column 7, 4-7); the portable communication terminal is capable of communicating the recorded information to a data center via a communication network (Column 12, 28-38).

Fisher does not disclose an "input button", "holed-out button", "uploading header", and the play data being stored in data storage unit.

However, Fisher discloses the golfer inputting the information via the recording means (Column 7, 5-8) and although it does not use a "holed-out button", golfers enter the information that the golfers holed-out and transmits the data to the host computer and although Fisher does not per se use an uploading header it discloses that the golf information is transferred on a real time basis allowing member in the club house to follow the golf game (Column 5, 55-62). Thus it would be obvious to one skilled in the art to use a "holed-out" button and inherently Fisher must use a type of uploading header because individual golfer's information is track-able to an individual golfer.

Fisher does disclose updating individual storage data obtained after the shot, although not in the data storage unit but in the portable communication terminal (Column 12, 28-38). And it would be obvious to store the information in a datacenter and is contemplated by Fisher (Column 9, 42-50).

18. With respect to **Claim 5**: Fisher discloses a group data storage unit that manages data on performance of a sub-group in which members are carrying the portable communication terminal and Fisher distributes the individual play data to each

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portable communication terminal of the sub-group when it is determined all members of the sub group have holed out. (Column 1, 55-60 and Column 10, 26-30 and Column 12 50-59).

Although Fisher does not use the terms "group data storage unit" and "distribution processing unit", Fisher carries out all of the same functions allowing an individual gofer to record his play data and have it transmitted to other portable communication terminals with in her sub-group and it would be obvious to a person having ordinary skill in the art that in order to carry out Fisher's model that a "group storage unit" is or could be used, along with a "distribution processing unit" in order to allow an individual to record his/her golf data.

19. With respect to **Claim 6**: Fisher discloses keeping track of sub-group play data based upon measurement data obtained (Column 12, 53-55).

20. With respect to **Claim 12**: Fisher stores individual performance data of players with in a sub-group or plurality thereof, his method also allows a read out of individual data real time or when all members of sub-group have holed out and this information is distributed to members in said sub-group (Column 4, 30-42).

21. **Claims 9-11** in the alternative, under 35 U.S.C. 103(a) as obvious over Barber.

With particular attention paid to independent **Claim 9** and the amendment found therein : Barber discloses all of the limitations due to the fact that the amendment includes "signal line". IF for purposes of Examination that term where not there Examiner would not have the 102 rejection as laid out above. Examiner now takes the time to note that the Applicants "separate input device" amendment falls under several

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statutory categories of obviousness because the difference between the prior art and Applicant's invention relate to portability, size and severability.

Barber does not disclose that two portable devices may be used to carry out his invention one to be carried by a player and another one to be carried by the player.

However, in view of Chapter 2144 in the MPEP the one of ordinary skill in the art would at the time of the invention be motivated to modify Barber. (See Changes in **Size/Proportion**; In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Furthermore, **Making Portable** In re Lindberg, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) (Fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results.).

Moreover, **Making Separable** In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was

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fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barber to make the portable device separate because case law has held to make a device severable is obvious.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barber, so that the size of the portable device would be reduced in one's pocket and thus more portable/less intrusive in user pocket during a golf swing.

22. **Claims 13 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher as applied to claims 9 and 10 above, and further in view of Official Notice.

23. With respect to **Claim 13**: Official Notice is taken that it is obvious, old, and well known to charge for the use of internet, wireless, or cell-phone devices for fixed amount or service charge for amount of data provided.

Fisher discloses checking out the portable communication terminal (because it is mounted in a golf cart and golf carts are rented from the club house and the host computer is located in the club house) and mentions the possibility of displaying commercials on the portable communication device (Column 7, 23-26).

Fisher does not disclose charging per advice request.

However, because Fisher does rent out the device and foresees the commercial nature of the device (he anticipated commercials), it would be obvious to one having ordinary skill in the art at the time of the invention to charge on a per request basis. Official Notice is taken that it is obvious to charge for services.

24. With respect to **Claim 14**: Fisher discloses lending the communication terminal to a player (Fisher mounts the portable communication terminal in a golf cart and golf carts, tools and services are rented/lent out), registering the player in the datacenter (Fig 20. and Column 8, 57 -63), transmitting of play data to a data center (Column 5, 55-67), storing and managing play data in an individual storage unit (Column 6, 49-53), transmitting course map data or advice data to portable communication terminal, and although it does not charge per advice request, Official Notice is taken that to charge for use of a tool is old and well known and it would be obvious to do so..

Response to Arguments

25. Applicant's arguments with respect to claims 1-6 and 9-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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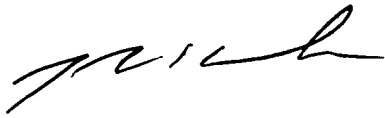
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB
8/9/2005



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